

**REMARKS/ARGUMENTS**

The Office Action mailed August 1, 2005, has been received and its contents carefully considered. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed August 1, claims 1-3, 5-12 and 14-18 stand rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

Claims 4 and 13 have are cancelled. No claims are added. As such, claims 1-3, 5-12, and 14-18 remain pending.

**CLAIM REJECTION – 35 U.S.C. § 103(a)**

Claims 1-3, 5-12 and 14-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,062,846 to Oh et al in view of U.S. Patent 5,501,693 to Gravener. Specifically, as to claims 1-3 and 8, the Office Action states that Oh et al. teaches “a surgical clip 10 comprising a first 12 and a second 14 leg members joined by a resilient hinge 16, each leg member having an inner and outer surface, the first leg member terminating at its distal end in a deflectable hook 22 member curved toward the second leg member, the second leg member terminating at its distal end in a locking portion complementary to the hook member, the hook member having a continuously curved outer surface (Fig. 1)” and that “Oh also teaches a means for securing the vessel when the clip is in the closed position (protrusions 1302, 1304).” However, the Office Action admits that “Oh is silent with regards to the clip comprising complementary parts of an interlock mechanism formed along a portion of the vessel clamping

inner surface of each of the first and second leg members; and wherein the interlock mechanism includes a ridge portion and a groove portion that are aligned when the clip is in the closed position.”

The Office Action further states that “Gravener also teaches a surgical clip for occluding a vessel comprising a first and second arm, and wherein complementary parts of an interlock mechanism is formed along a portion of the vessel clamping inner surface of each of the first and second leg members, wherein the interlock mechanism includes a ridge portion 36 and a groove portion 38; and wherein the ridge and groove portions are aligned in the closed position (Fig. 6).”

The Office Action finally concludes that it would have been obvious to one of ordinary skill in the art to “modify the clip of Oh to include the interlock mechanism taught by Gravener.” Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a).

First, Applicants contend that a *prima facie* case of obviousness has not been established. Specifically, Applicants contend that to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142. Furthermore, the teaching or suggestion to make the claimed combination must both be found in the prior art, and not based on the Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants contend that the Office Action has not set forth the requisite suggestion or motivation to combine the teachings of Oh and Gravener to arrive at the claimed invention, and instead has used impermissible hindsight, using the benefit of the disclosure of Applicants’ invention, to conclude that it would have been obvious to one of ordinary skill in the art to “modify the clip of Oh to include the interlock mechanism taught by Gravener.”

As specifically stated in MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants contend that the teachings of Gravener do not provide any evidence of the desirability of combining the clip of Gravener with the clip of Oh, but instead actually teach away from such a combination. This is because while Oh and the present invention are directed to a removable clip which opens and closes about a hinge portion and includes a locking mechanism, Gravener teaches a deformable clip without any hinge or integral locking mechanism. Instead, the clip of Gravener, once applied, do not lock and unlock to be repeatedly applied and removed. Therefore, there is no suggestion in Gravener to apply the tongue and groove portions disclosed therein, to a reversibly applicable clip with a hinge and locking mechanism such as disclosed in either Oh or the present invention.

The present invention, as recited in independent claims 1, 8, 11, and 15, includes a “flexible” or “resilient” hinge, along with a “locking portion,” none of which is disclosed anywhere in Gravener. Instead, Gravener discloses clips which can be fabricated from steel or titanium, metals which are meant to be deformed. (Gravener, col. 4, lines 31-34). Further, Gravener teaches that the clips disclosed therein must be applied with special applier tools “to deform the clip” as described in US Patents No. 4,509,518, No. 5,084,057, and No. 5,100,420, none of which disclose an applier for applying clips with hinge and locking portions as presented in the subject invention. (Gravener, col. 3, lines 9-20). Instead, clips such as those shown in Gravener must be deformed and are not suited to be opened and closed about a hinge means with a locking mechanism opposite the hinge means. Thus, the disclosure of Gravener teaches away

from any combination of Oh and Gravener to result in the invention as claimed in claims 1, 8, 11, and 15.

Since the clips in Gravener are the type which must be permanently deformed upon application, Applicants contend that it would not have been obvious to one of ordinary skill in the art to combine the teachings of Oh and Gravener to arrive at the claimed invention. Furthermore, the Office Action has not presented any evidence of any suggestion or motivation in the references to combine the references to arrive at the claimed invention. Nor has the Office Action set forth any reasoning or evidence that knowledge generally available to one of ordinary skill in the art is sufficient to combine Oh and Gravener to arrive at the claimed invention. Accordingly, Applicants respectfully assert that a *prima facie* case of obviousness has not been established, and that in any case, quite to the contrary, a finding of obviousness cannot be proper because the disclosure of Oh and Gravener instead teach away from a combination of the references to arrive at the claimed invention. Therefore, claims 1, 8, 11, and 15 are believed to be allowable and Applicants respectfully request that the rejection with regard to said claims be withdrawn.

Dependent claims 2-3, 5-7, 9-10, 12, 14, and 16-18 each depend, directly or indirectly, from one or another of independent claims 1, 8, 11, and 15. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims are believed to nonobvious and therefore patentable, their dependent claims are therefore believed patentable.

Therefore, applicants therefore respectfully request that the rejection with regard to claims 2-3, 5-7, 9-10, 12, 14, and 16-18 be withdrawn.

### CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21700.

Respectfully submitted,

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